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09/806,545	06/18/2001	Takeshi Fujita	450131-03247	1281

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EXAMINER	
ZHOU, TING	
ART UNIT	**PAPER NUMBER**
2173	

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/806,545	FUJITA ET AL.	
	Examiner	Art Unit	
	Ting Zhou	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15 and 17-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15 and 17-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on 6 October 2005 under 37 CFR 1.53(d) based on parent Application No. 09/806,545 is acceptable and a RCE has been established. An action on the RCE follows.

2. The amendments filed on 9 September 2005, submitted with the filing of the RCE have been received and entered. Claims 1-13, 15 and 17-24 as amended are pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 4-5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwamura U.S. Patent 6,807,285.

Referring to claim 4, Iwamura teaches a system comprising means for storing a displayable image into the image file (storing, or loading the displayable image data into a file format shown in Figure 11) (column 17, line 43-column 18, line 4); means for embedding a pointer to information used to display the displayable image and an instruction for handling the information (embedding public key information k_p, which is used for embedding information D1, including the embedding location and the embedding procedure) (column 5, lines 34-41 and Figure 11), the pointer and the instruction configured to be dealt as one pair so that at least one pair of the pointer and the instruction is recorded (embedding information D1 includes the embedding location, embedding procedure and the digital watermark) (column 5, lines 15-28, 34-41, column 6, lines 23-31 and column 17, line 57 – column 18, line 4 and Figure 11), wherein the pointer and the instruction are embedded in an area of the image file that is not used for displaying the image (the embedded watermark, public key information and other information used to display the image such as the size of the image are stored in the image header field, which is not displayed when displaying the image from the image file; when displaying the image file, only the image data itself is displayed) (column 5, lines 41-60, column 6, lines 23-31 and column 17, line 57 – column 18, line 4 and Figure 11), wherein the means for embedding prevents unauthorized redirecting from the displayable image (embedding the watermark with the image data prevents illegal copies or alteration/destruction of the image) (column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31).

Referring to claim 5, Iwamura teaches an index for a menu item corresponding to the image file (index list of attributes for the image) (column 19, lines 24-27) and identification information of an entity of a predetermined program (supplying identification information for the image file such as a digital watermark) (column 5, lines 15-28).

Referring to claim 7, Iwamura teaches an information processing means for reading out the image file in response to a request from a terminal device and returning it to the terminal device (reading out, or extracting embedded second information from digital data in order to recover the first information) (column 4, line 10-18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura U.S. Patent 6,807,285 and Hoyle U.S. Patent 6,141,010.

Referring to claim 1, Iwamura teaches a system comprising means for receiving a displayable image and related data to the displayable image (the apparatus is supplied, or receives a displayable image G and related data, such as public key information and embedding information) (Iwamura: column 5, lines 15-21 and lines 53-61); means for recording the displayable image into the image file (recording, or loading the image data and related

information into a file format shown in Figure 11) (Iwamura: column 17, line 43-column 18, line 4); and means for preventing unauthorized redirecting from the displayable image by embedding the related data into the image file, which already includes the displayable image (embedding related data such as the watermark and confidential information into the image file comprising the image data G in order to prevent illegal copies or alteration/destruction of the image) (Iwamura: column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31). However, Iwamura fails to explicitly teach the related data includes pointers to at least one item of information enabling redirection from the displayable image to a site having the at least one item of information. Hoyle teaches a system that stores a displayable image and related data together as an image file or set (Hoyle: column 14, line 59-column 15, line 6 and Figure 7) similar to that of Iwamura. In addition, Hoyle further teaches the related data includes pointers to at least one item of information enabling redirection from the displayable image to a site having the at least one item of information (the image file data sets comprise a number of user selectable links, or pointers, that will cause redirection to the corresponding URL site upon selection) (Hoyle: column 4, lines 19-49). It would have been obvious to one of ordinary skill in the art, having the teachings of Iwamura and Hoyle before him at the time the invention was made, to modify the image file of Iwamura to include the pointers taught by Hoyle. One would have been motivated to make such a combination in order to provide a secure and authorized way for users to browse through sites on the Internet; for example, by allowing the redirection of only links that are associated with a particular image, the data integrity and security of the image/file is protected.

Referring to claim 2, Iwamura, as modified, teach a system comprising a file generator configured to generate the image file including a first area and a second area (creating a file of

the format including two areas, an image header field and an image data field) (Iwamura: column 17, lines 43-60 and Figure 11), the file generator including a first area recorder configured to record first data used to display a displayable image onto the first area (the image file is divided into a first area configured to record data used to display an image, or the image data file storing the image data itself) (Iwamura: column 17, line 57 – column 18, line 4 and Figure 11); and a second area recorder configured to record second data related to but not used to display the displayable image onto the second area (the image file is divided into a second area configured to record data related to but not used to display the image, or the image header field, recording information such as a digital watermark, key information, image attribute information, etc.) (Iwamura: column 17, line 57 – column 18, line 4 and Figure 11), the second area recorder operating to record the second data to prevent unauthorized redirecting from the displayable image (the watermark recorded in the image header field prevents illegal copies or alteration/destruction of the image) (Iwamura: column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31), wherein the second data includes pointers to at least one item of information enabling redirection from displayable image to a site including the at least one item of information (the image file data sets comprise a number of user selectable links, or pointers, that will cause redirection to the corresponding URL site upon selection) (Hoyle: column 4, lines 19-49).

Referring to claim 3, Iwamura, as modified, teach a system comprising an image recorder configured to record a displayable image in the image file (recording, or loading the displayable image data into a file format shown in Figure 11) (Iwamura: column 17, line 43-column 18, line 4); a data embedding apparatus configured to prevent unauthorized redirecting from the

displayable image by embedding related data related to the displayable image in an area of the image file that is ignored when data from the image file is used to display the displayable image (the embedding apparatus embeds related data such as the watermark and confidential information into the image file comprising the image data G in order to prevent illegal copies or alteration/destruction of the image; the embedded watermark and image header information are ignored, or not displayed when displaying the image from the image file; when displaying the image file, only the image data itself is displayed) (Iwamura: column 5, lines 41-60, column 6, lines 23-31 and column 17, line 57 – column 18, line 4), the related data including pointers to at least one item of information enabling redirection from the displayable image to a site including at least one item of information (the image file data sets comprise a number of user selectable links, or pointers, that will cause redirection to the corresponding URL site upon selection) (Hoyle: column 4, lines 19-49).

Referring to claim 6, Iwamura, as modified, teach a method comprising receiving a displayable image and related data related to the displayable image (the apparatus is supplied, or receives a displayable image G and related data, such as public key information and embedding information) (Iwamura: column 5, lines 15-21 and lines 53-61); recording the displayable image into the image file (recording, or loading the image data and related information into a file format shown in Figure 11) (Iwamura: column 17, line 43-column 18, line 4); and preventing unauthorized redirecting from the displayable image by embedding the related data into the image file, which already includes the displayable image (embedding related data such as the watermark and confidential information into the image file comprising the image data G in order to prevent illegal copies or alteration/destruction of the image) (Iwamura: column 1, lines 33-48,

column 5, lines 41-47 and column 6, lines 23-31), wherein the related data includes pointers to at least one item of information enabling redirection from the displayable image to a site having the at least one item of information (the image file data sets comprise a number of user selectable links, or pointers, that will cause redirection to the corresponding URL site upon selection) (Hoyle: column 4, lines 19-49).

5. Claims 8-13, 15, 17 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle U.S. Patent 6,141,010 and Iwamura U.S. Patent 6,807,285.

Referring to claim 8, Hoyle teaches a computer program comprising executable instructions that cause a computer to execute the steps of: monitoring an access to an information image file managed in a first managing area of the informational image file (the first window region displayed on the GUI comprises user-selectable items, associated with image files, or data sets) (Hoyle: column 4, lines 19-32), displaying an image based on image related information included in the information image file on a second managing area, and managing the information image file on the second managing area, when the information image file managed in the first managing area is accessed (the second program module, in response to user selection of one of the links in the first window region, can select associated information, stored as data sets, or image files, in the database, to be displayed in the second, or information display region) (Hoyle: column 4, lines 32-49), monitoring an access to an information image file managed in the second managing area of the informational image file, accessing and executing a file pointed to by the predetermined pointer or a corresponding file stored in advance on a local recording medium, when the information image file managed in the second managing area is accessed (in response

to user interaction with the computer, such as user clicking on a banner advertisement displayed in the second, or information display region, the programs, or links associated with the advertisement are initiated) (Hoyle: column 9, lines 49-59). For example, as shown in Figures 5, 5a and 7, in response to the category selected by the user from the first managing area comprising the hierarchical display of selectable categories (Hoyle: Figure 5a), corresponding banner ad 78 is displayed in the second managing area (Hoyle: Figure 5), and upon user selection of the advertising banner, the user is directed to the corresponding link associated with the banner; the information associated with each banner is stored as an image file data set in the database (each row of the banner database) (Hoyle: Figure 7). However, although Hoyle teaches storing the image file and image related information together as one data set (Hoyle: column 14, line 59 – column 15, line 6 and Figure 7), Hoyle fails to explicitly teach preventing unauthorized redirecting from the image by including the image on the first managing area and the image related information on the second managing area in the same information image file. Iwamura teaches a recording apparatus that stores image data and image related information together (Iwamura: column 17, line 58 – column 18, line 4 and Figure 11) similar to that of Hoyle. In addition, Iwamura further teaches preventing unauthorized redirecting from the image by including the image on the first managing area and the image related information on the second managing area in the same information image file (embedding image related information such as a watermark or some confidential information with the digital image to protect and manage the copyright of the original image) (Iwamura: column 3, lines 16-48, column 5, lines 15-47 and column 6, lines 23-31). It would have been obvious to one of ordinary skill in the art, having the teachings of Hoyle and Iwamura before him at the time the invention was made, to modify

the image file processing program for managing the image and image related information of Hoyle to include storing the image and image related information in the same image file, taught by Iwamura. One would have been motivated to make such a combination in order to protect and manage the copyright of the image, preventing illegal copying and alteration of the contents of the image.

Referring to claim 9, Hoyle, as modified, teach an access to an information image file managed in the first managing area being a drag and drop operation for a corresponding image (Hoyle: column 10, lines 11-18).

Referring to claim 10, Hoyle, as modified, teach an access to an information image file managed in the first managing area being a selection operation for a menu displayed with respect to the corresponding image (Hoyle: column 9, lines 39-44 and further shown by reference character "70" in Figure 5).

Referring to claim 11, Hoyle, as modified, teach an access to an information image file managed in the first managing area being a drag and drop operation for a menu (drag and drop operations for adding or removing buttons on the toolbar menu) displayed with respect to a corresponding information image file (Hoyle: column 11, lines 21-29).

Referring to claim 12, Hoyle, as modified, teach an access to an information image file managed in the first managing area being a click operation for a corresponding image (Hoyle: column 9, lines 57-59 and column 15, lines 3-6).

Referring to claim 13, Hoyle, as modified, teach an access to an information image file managed in the first managing area being a drag and drop operation for a corresponding information image file (Hoyle: column 10, lines 11-18).

Referring to claim 15, Hoyle, as modified, teach the first managing area being a window for viewing a web page of a WWW browser, a window for viewing a body of e-mail software, a window for checking an attached file of e-mail software, a folder window for referring a file stored on a recording medium, or a window which is displayed by operating input means for an image or an image file (the first managing area displays a graphical user interface comprising a window capable of displaying links to different information sources, such as WWW pages or image files such as banners) (Hoyle: column 4, lines 22-35).

Referring to claim 17, Hoyle, as modified, teach the first managing area and second managing area formed and managed by independent programs (the first managing area is formed and managed by the first program module, or GUI module and the second managing area is formed and managed by the second program module, or the ADM module) (Hoyle: column 4, lines 19-50 and column 6, lines 62-65).

Referring to claim 19, Hoyle, as modified, teach a view of the first managing area and a view of the second managing area displayed simultaneously with a frame, as shown in Figures 5 and 5a of Hoyle, where the area for displaying ads is shown in the same window, or frame, as the GUI containing the menu item icons for manipulating the interface display.

Referring to claim 20, Hoyle, as modified, teach when an access is made to an information image file managed in a first markup description language file which is a first managing area, a second markup description language file which is a second managing area is read out from memory means, and, after the second markup description language file is updated so that the second markup description language file manages the information image file, the second markup description language file is executed (when the user selection of a link in the first

program module is detected, the second program module is operable to select and display the informational data) (Hoyle: column 4, lines 19-49).

Referring to claims 21-24, Hoyle, as modified, teach an information processing means for reading out the image file in response to a request and displaying the image file on a display device (in response to user selection of a category shown in Figure 5a, such as "Sports", "Players", etc., an associated banner advertisement image associated with the category selection will be displayed) (Hoyle: column 4, lines 19-49, column 5, lines 48-67 and column 9, lines 49-59).

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle U.S. Patent 6,141,010 and Iwamura U.S. Patent 6,807,285, as applied to claims 8 and 17 above, and Shaw et al. U.S. Patent 5,809,242.

Referring to claim 18, Hoyle and Iwamura teach all of the limitations as applied to claims 8 and 17 above. However, Hoyle and Iwamura fail to explicitly teach view selection tabs for selecting one of views of a first managing area and a view of a second managing area. Shaw et al. teach an image file (banner) processing device similar to that of Hoyle and Iwamura. In addition, Shaw et al. further teach displaying view selection tabs for selecting one of views of a first managing area (first managing area tab for reading emails) and a view of a second managing area (second managing area tab for writing emails) in order to display selectively the managing area at a side of a tab selected through input means (Shaw et al.: column 16, lines 66-67 and continuing onto column 17, lines 1-19 and Figure 8). It would have been obvious to one of ordinary skill in the art, having the teachings of Hoyle, Iwamura and Shaw et al. before him at

the time the invention was made, to modify the image file processing systems of Hoyle and Iwamura to include the use of selection tabs taught by Shaw et al. It would have been advantageous to make such a combination in order to better organize the display of information shown to the user; separating information categories into groups and displaying them in separate tabs will allow the users to see all the functions and information relating to one group, without getting confused by the cluttered display of mixed information from multiple groups.

Response to Arguments

7. Applicant's arguments filed 6 September 2005 have been fully considered but they are not persuasive.

8. With respect to claim 4 and similar to claims, the applicant argues that while Iwamura teaches embedding information into digital data such as a digital image using a digital watermark, Iwamura fails to teach of suggest embedding information in an area of the image file that is not used for displaying the displayable image. The examiner respectfully disagrees. For example, Figure 11 shows a general image file format that is divided into two areas, an area that is used for displaying the displayable image, i.e. the image data unit and an area that is not used for displaying the displayable image, i.e. the image header unit (information in the image header unit are not displayed when the image is displayed); this is also recited in column 17, line 56-column 18, line 4. As further shown in Figure 11, information embedded in the image header unit includes information such as a public key information k_p, which is used for embedding information D1, including the embedding location and the embedding procedure (column 5, lines

15-28 and 34-41) and image attribute information such as the displayed size and an offset to a storage location of the image data (column 17, line 56-column 18, line 4). Therefore, the both the pointer and instructions for handling the information are stored in the image header unit, which cannot be seen, i.e. is not displayed when the image is displayed.

9. With respect to claims 1 and 8 and similar claims, the applicant argues that Iwamura merely teaches the protecting and managing of the copyright of the original image data and does not teach or suggest a means for preventing unauthorized redirecting from the displayable image. As a first note, the examiner respectfully asserts that limitations such as "preventing unauthorized redirecting from the displayable image" are statements of the intended use and merely suggests limitations or makes limitations optional but do not require steps to be performed, limit an apparatus to a particular structure, nor limit the scope of a claim or claim limitation (see MPEP 2106). Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The applicant's intended use of embedding data for preventing unauthorized redirecting from an image does not patentably distinguish the claimed invention from Iwamura. Iwamura teaches embedding data into an image file in the same manner as the system presently claimed in the applicant's invention. The embedding system and method of Iwamura is capable of performing the applicant's intended use of preventing unauthorized redirecting from the

displayable image. In addition to that, the examiner further respectfully disagrees with the applicant's argument that Iwamura does not teach or suggest a means for preventing unauthorized redirecting from the displayable image. Iwamura teaches that the embedding method is advantageous because it prevents unauthorized redirection, i.e. eliminates the destruction or alteration of information, in the image, such as embedded information D1, as recited in column 6, lines 23-31.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ

CAO (KEVIN) NGUYEN
PRIMARY EXAMINER